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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,431	03/06/2002	Siba K. Samal	108172-00070	2502

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EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 09/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,431

Applicant(s)

SAMAL ET AL.

Examiner

Shanon Foley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, 19, 26 and 27, drawn to a Newcastle disease vaccine comprising at least two specific features.

Group II, claim(s) 8, drawn to an isolated nucleic acid comprising a sequence described in Figure 2.

Group III, claim(s) 9, drawn to an isolated nucleic acid of up to 200 nucleotides comprising 55 nucleotides of the leader sequence of Figure 2.

Group IV, claim(s) 10, drawn to an isolated nucleic acid of up to 350 nucleotides comprising 113 nucleotides of the trailer region of Figure 2.

Group V, claim(s) 11 and 12, drawn to an isolated nucleic acid of 2500 nucleotides comprising the NP region of Figure 2.

Group VI, claim(s) 13-18, drawn to a method of making a Newcastle disease virus.

Group VII, claim(s) 20, drawn to an isolated protein.

Group VIII, claim(s) 21-23, drawn to a synthetic cDNA encoding an infectious Newcastle disease virus.

Group IX, claim(s) 24 and 25, drawn to a method of making an infectious Newcastle disease virus.

The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The special technical feature of group I is drawn to a first product, a Newcastle disease vaccine comprising at least two specific features recited in the claims. Any subsequent group that does not share the special technical feature defining group I, lacks unity of invention.

The special technical feature of group II is a second product, drawn to an isolated nucleic acid comprising the sequence described in figure 2. According to page 6, lines 7-9, Figure 2 depicts the complete gene map of the genome of NDV strain Beaudette C. This nucleic acid of group II lacks unity of invention with group I because the product of group I comprises at least two features which distinguish it from NDV strain Beaudette C. Therefore, the products of groups I and II lack unity of invention.

The special technical feature of group III is drawn to a third product, an isolated nucleic acid of up to 200 nucleotides comprising 55 nucleotides of the leader sequence of Figure 2. This group lacks unity of invention with the products of groups I or II because the product of group III does not share the same structural or functional features defining group I or II.

The special technical feature of group IV is drawn to a fourth product, an isolated nucleic acid of up to 350 nucleotides comprising 113 nucleotides of the trailer region of Figure 2. This group lacks unity of invention with the products of groups I, II or III because the product of group IV does not share the same structural or functional features defining group I, II or III.

The special technical feature of group V is drawn to a fifth product, drawn to an isolated nucleic acid of 2500 nucleotides comprising the NP region of Figure 2. This group lacks unity of invention with any of the products of groups I-IV because the product of group V does not share the same structural or functional features defining groups I-IV.

The special technical feature of group VI is drawn to a method of making a Newcastle disease virus. This method lacks unity of invention with groups I-V because the method does not use or make any of the specific products claimed in groups I-V and does not share the same special technical features defining groups I-V.

The special technical feature of group VII is drawn to a sixth product, drawn to an isolated protein. This group does not share any of structural or functional characteristics defining the special technical features of groups I-VI.

The special technical feature of group VIII is drawn to a seventh product, drawn to a synthetic cDNA encoding an infectious Newcastle disease virus. This group does not share any of structural or functional characteristics defining the special technical features of groups I-VII.

The special technical feature of group IX is drawn to a second method of making a Newcastle disease virus using the seventh product. This method lacks unity of invention with groups I-VIII because the method does not use or make any of the specific products claimed in groups I-VIII and does not share the same special technical features defining groups I-VIII.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (703) 308-3983. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Shanon Foley